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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,268	04/03/2000	DANIEL RICHARD SCHNEIDEWEND	RCA89068	9731

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EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,268

Applicant(s)

SCHNEIDEWEND ET AL.

Examiner

Matthew R Demicco

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 9/29/03. Claims 1-17 are pending. Claims 1, 6, 11-13 and 16-17 have been amended. The Examiner's objections to the Drawings and Specification are hereby withdrawn in light of the amendment.

Response to Arguments

2. Applicant's arguments with respect to Claims 1, 6, 11-12, and 13 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed with respect to Claims 16 and 17 have been fully considered but they are not persuasive. Applicant argues that LaJoie does not describe removing automatically the programming from the first list if it is removed from the second list. The Examiner maintains that removing would be inherent for the simple reason that if a user decides to remove a program from a list of programs to be purchased, that program cannot be recorded. Use of conflict management as suggested by Applicant would not be appropriate since the user has made a conscious decision to remove the program. Asking the user if they want to add the program to the list from which they specifically requested the program to be removed from would be counter-intuitive.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,850,218 to LaJoie et al. in view of U.S. Patent No. 6,157,413 to Hanafée et al.

Regarding Claim 1, LaJoie discloses an apparatus for receiving a plurality of programs comprising a user interface for selecting a program from a plurality of programs and selecting a user action (See Figure 16). LaJoie also discloses a controller, which in response to a first user action for selecting a first program for recording, stores the first program in a first list representing a list of programs to be recorded (Col. 21, Lines 15-23). In response to a second user action for selecting a second program for both purchasing and recording, the controller stores the second program on a second list representing a list of programs purchased and also stores the program on the first list (Col. 29, Lines 33-58 and Figures 12 and 13). What LaJoie does not disclose, however, is an on screen user option to both purchase and record the selected program. Hanafée discloses a system controlled by a TV viewer remote control that displays current or future programming information (See Figure 9) and displays an on screen user option to both purchase and record a selected program (See Figures 4-7). The dialogue box in the center of the screen reads on the claimed on screen user option. Hanafée is evidence that ordinary workers in the art would recognize the benefits of allowing a user to purchase

and record a program from a single on screen user option dialogue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of LaJoie with the purchase and recording dialogue of Hanafee in order to allow a user to manage purchasing and recording tasks from a simple, user-friendly interface.

Regarding Claim 2, LaJoie in view of Hanafee disclose a system as stated above in Claim 1. LaJoie further discloses a system wherein the first list includes a timer conflict indication for programs having a timer conflict (Col.21, Lines 30-42 and Figure 12).

Regarding Claim 3, LaJoie in view of Hanafee disclose a system as stated above in Claim 1. LaJoie further discloses a system wherein the first list includes a purchase indication for the second program (See Figure 14).

Regarding Claim 4, LaJoie in view of Hanafee disclose a system as stated above in Claim 1. LaJoie further discloses a system wherein the controller first determines whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list (Col. 21, Lines 30-55).

Regarding Claim 5, LaJoie in view of Hanafee disclose a system as stated above in Claim 1. LaJoie further discloses a system wherein the controller prompts a user to resolve the timer conflict if one exists (Cols. 21-22, Lines 55-5 and Figure 12).

Regarding Claim 6, LaJoie in view of Hanafee disclose an apparatus for processing a program comprising a controller for displaying a first list representing programs selected for recording (See LaJoie Figure 12), displaying a second list representing programs selected for purchasing (See LaJoie Figure 13) and in response to

a user selection of a program for both purchasing and recording, automatically entering the program into both lists as stated above in Claim 1.

Regarding Claims 7-10, see Claims 2-5 respectively, as stated above.

Regarding Claim 11, LaJoie in view of Hanafée disclose an apparatus for processing a program comprising a user interface means for selecting a program from a plurality of programs and an on screen user option to both purchase and record the program as stated above in Claim 1. LaJoie also discloses a controller, which, in response to a user action for canceling a program, removes the program from a first list representing a list of programs to be purchased and from a second list representing a list of programs to be recorded (Col. 22, Lines 52-56). Because LaJoie discloses adding a second program to both a first list of programs to be recorded and a second list of programs to be purchased in addition to disclosing the ability to cancel programs to be purchased (Col. 22, Lines 25-28), it is inherent that the program being purchased, if being recorded, would be removed from both lists by a determination means. If this feature were not present, the set-top box would try to record a pay-per-view program that had no prior purchase arrangements resulting in an error

Regarding Claim 12, LaJoie in view of Hanafée disclose an apparatus for processing a program comprising on screen display means for displaying a first list representing programs selected for recording, user control means for selecting to both purchase and record a program and on screen display means for displaying a second list representing programs selected for purchasing as stated above in Claim 6. LaJoie further discloses user control means for removing a program from the first and second lists and

control means, which in response to the user removal of the program from the second list, automatically removes the program from the first list if the program appears as stated above in Claim 11.

Regarding Claim 13, LaJoie in view of Hanafée disclose a method for processing a plurality of programs comprising the steps of selecting a first program for recording from a plurality of programs, storing the program in a first list, selecting a second program, receiving a selection of a displayed user option for both purchasing and recording of the second program, storing the second program in a second list representing programs purchased, and storing, automatically, the second program in the first list as stated above in Claim 1.

Regarding Claim 14, LaJoie in view of Hanafée disclose a method as stated above in Claim 13 further comprising the step of determining whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list as stated above in Claim 4.

Regarding Claim 15, LaJoie in view of Hanafée disclose a method as stated above in Claim 13 further comprising the step of prompting the user to resolve a timer conflict if one exists as stated above in Claim 5.

Regarding Claim 16, LaJoie in view of Hanafée disclose a method for processing a plurality of programs comprising selecting a first program for removing from a first list representing a program list of programs selected for recoding, selecting a second program for removing from a second list representing a list of programs purchased, and

determining whether the second program appears on the first list and automatically removing it if so as stated above in Claim 11.

Regarding Claim 17, LaJoie in view of Hanafee disclose a method of processing a program as stated above. LaJoie further discloses a method comprising removing, in response to a user command, the program from a first list of programs representing programs scheduled for recording (Col. 22, Lines 52-56). Further, LaJoie discloses a controller as stated above in Claim 1 wherein a user can select a first program for recording which is stored in a first list and a second program for purchasing and recording which is stored on both a second and first list. LaJoie also discloses a controller, which, in response to a first user action for canceling a first program for recording, removes the first program from a first list representing a list of programs to be recorded (Col. 22, Lines 52-56). Because LaJoie discloses adding a second program to both a first list of programs to be recorded and a second list of programs to be purchased in addition to disclosing the ability to cancel programs to be recorded (Col. 22, Lines 52-56), it is inherent that the system of LaJoie would have determining means for automatically removing a program from a second list of programs to be purchased if the program was removed from the first list. This would be necessary in order to prevent a condition where a user inadvertently pays for a pay-per-view video without actually ever watching or recording it. This reads on the claimed method of determining whether the program is also a purchased program, and removing, automatically, the program from a second list of programs representing purchased programs, if the program is also a purchased program.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



mrd
December 18, 2003


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600